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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,690	06/22/2000	Thomas J. Perkowski	100-035USA000	7979

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EXAMINER

BROWN, TIMOTHY M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/599,690

Applicant(s)

PERKOWSKI, THOMAS J.

Examiner

Tim Brown

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-6 have been examined.

Specification

2. The specification is objected to because the continuing data improperly cross-references application number 09/284,197 which shares no common inventor with the present application. Appropriate correction is requested.

Oath/Declaration

3. The declaration is objected to because the claim of priority under 35 U.S.C. § 120 improperly references application number 09/284,197. Application number 09/284,197 shares no common inventor with the present application. Appropriate correction is requested.

Information Disclosure Statement

4. The Examiner notes an information disclosure statement was submitted December 20, 2002 and recorded as paper no. 7. However, this information disclosure statement does not appear in the record. It is respectfully requested that Applicant resubmit the information disclosure statement so that the record reflects the references contained therein were considered.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 3625

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6 and 10 of U.S. Patent No. 5,918,214 (hereinafter "patent claims"). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6 are directed to an obvious embodiment of the patent claims.

The patent claims are directed to a system for using UPNs to access product information over the Internet. The system features a URL/UPN storage means for storing a plurality of URLs symbolically linked to a plurality of UPNs (see US 5,918,214 at col. 15, lines 57-64). Claims 1-6 relate to a system and method for generating and storing a plurality of URL/UPN data links. Because a URL/UPN data link must be generated before it can be recorded, it would have been obvious to develop the presently claimed means for generating URL/UPN data links.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Appropriate correction of the claims is requested.

Claim 1

Claim 1 recites "every UPN-indexed product" in line 3. Claim 1 lacks sufficient antecedent basis for this limitation.

Claim 1 also recites "the manufacturer" in line 3. Claim 1 lacks sufficient antecedent basis for this limitation.

Finally, claim 1 is rejected under 35 U.S.C. 112, second paragraph for claiming an apparatus by its function. MPEP § 2173.05(g) provides claim limitations for an apparatus must define what the invention is, and not what it does. Claim 1 is directed to a "consumer product information catalog subsystem. . . ." However, claim 1 fails to recite an interconnection of physical limitations. Rather, claim 1 recites a number of functions for the consumer product information catalog subsystem such as "storing and managing media-rich consumer product information. . . ." Therefore, claim 1 is indefinite for claiming an apparatus by its function.

Claim 2

Claim 2 recites "the LAN or WAN" in line 3. Claim 2 lacks sufficient antecedent basis for this limitation.

Claim 2 also recites "the manufacturer" in lines 3 and 6. There is insufficient antecedent basis for this limitation in the claim.

Finally, claim 2 recites “most likely under the supervision of one or more consumer product brand-managers” in lines 8 and 9. The use of “most likely” renders the scope of the claim indefinite because it is unclear whether the claim includes the limitation “under the supervision of one or more consumer product brand-managers.”

Claim 3

Claim 3 recites “for each UPN-indexed product” in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 also recites “one or more computer programs (e.g. scripts)” in line 3. The recitation of “(e.g. scripts)” renders the scope of the claim indefinite because it is unclear whether the claim actually encompasses scripts.

Claim 4

Claim 4 is rejected under 35 U.S.C. 112, second paragraph for defining an apparatus by its function. MPEP § 2173.05(g) provides claim limitations for an apparatus must define what the invention is, and not what it does. Claim 4 is directed to a “consumer product information management subsystem . . . that can easily used [sic] with the manufacturer’s enterprise in a way which provides the brandmanager with a choice either storing the URLs . . . or copyable into the RDBMS” Being ‘easily used to provide a brandmanager with a choice of storing URLs’ or ‘copying URLs into a RDBMS’ defines a function of the invention of claim 4. It does not however describe an interconnection of physical elements. Therefore, claim 4 is indefinite for claiming an apparatus by its function.

Claim 5

Claim 5 recites "the information fields" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 also recites "each UPN-indexed product" in line 5. Claim 5 lacks sufficient antecedent basis for this limitation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Hudetz et al. (US 5,978,773 (hereinafter "Hudetz")).

Regarding claim 1, Hudetz discloses a consumer product information catalog subsystem for storing and managing media-rich consumer product information content relating to each and every UPN-indexed product that the

manufacturer makes, sells and/or distributes to retailers along the retail supply and demand chain (see Abstract).

Regarding claims 2 and 4, Hudetz discloses a consumer product information catalog subsystem realizable as a standalone database application supported on one or more client machines operably connected to the LAN or WAN of the manufacturer's enterprise, and/or as a network database information server connected to the LAN or WAN and being accessible to various consumer product information managers working within the manufacturer's enterprise, and using Web-enabled client machines to carry out consumer product information content management operations across the enterprise, most likely under the supervision of one or more consumer product brand-mangers, responsible for branding of such consumer products (col. 5, lines 6-29; col. 6, lines 27-32; and col. 7, lines 43-49).

10. Claims 3, 5 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilz, Sr. et al. (US 5,992,752) (hereinafter "Wilz").

Regarding claim 3, 5 and 6, Wilz discloses a consumer product information catalog subsystem (RDBMS) for use within an Internet-based consumer product information management, distribution and serving system, wherein one or more computer programs are provided in the RDBMS for the purpose of (i) analyzing the information fields of the RDBMS, (ii) automatically generate a set of UPN/URL/Trademark/product-descriptor data links for each UPN-indexed product with the RDBMS, (iii) locally store each such set of UPN/URL/Trademark/product-descriptor data links within the RDBMS, and (iv)

ultimately electronically data transport each such set of data links to a UPN/URL database management subsystem employed within a consumer product information management, distribution and serving system realized over the Internet (Abstract; col. 22, lines 1-18; col. 23, lines 55-67; and col. 24, lines 19-41).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Knowles et al. (US 5,869,819) Internet-based system and method for tracking objects bearing URL-encoded bar code symbols

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

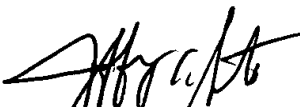
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Art Unit: 3625

Tim Brown
Examiner
Art Unit 3625

TB
April 13, 2003



Jeffrey A. Smith
Primary Examiner

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.